

# BEST AVAILABLE COPY

Application No.: 10/634464

Docket No.: 013183.0174PTUS

## REMARKS

Claims 1, 2, 10 – 16, 22, 24, 25, and 27 are pending in this application.

Applicant thanks the Examiner for several telephone conversations. A complete record of these conversations is included in the following Remarks.

In a telephone conversation on or about October 5, 2005, Applicant requested that the Examiner consider a draft Amendment and Remarks, and if some resolution could not be made of the issues discussed in the Amendment and Remarks, then it was requested that an interview take place. The draft Amendment and Remarks was faxed to the Examiner on October 5, 2005. On October 26, 2005, Applicant's attorney called the Examiner. No progress was made. Applicant's attorney pointed out the law cited in the Amendment and Remarks, and the Examiner stated that there was law supporting his position, but he could not provide it because no official response had been filed. A discussion was also held in which the undersigned attorney argued that Fu did not disclose the use of an aerogel without an odorant molecule attachment material. The Examiner indicated that in column 6, last paragraph, the Fu reference stated that the aerogel could be used without an odorant molecule attachment material. The undersigned agreed to review this paragraph. However, a review of this paragraph indicates that it discloses that the aerogel substrate has a thin coating of a detection polymer 54. See column 6, lines 55 and 56. Therefore, Applicant believes strongly that the claims differentiate over Fu, and that the law, as fully discussed below, is opposed to the Examiner's rejections. Applicant reiterates his request for an interview if the Examiner feels he cannot allow the claims.

Claims 1, 2, 10 – 16, 22, 24, 25, and 27 have been rejected under 35 USC 112, first paragraph, on the basis that the specification does not support the critical limitation that an odorant molecule attachment material cannot be used along with the high surface area material to prevent selective measurement of a particular contaminant. This rejection is respectfully traversed. This is not what is claimed. What is claimed is simply that the "measurement element (is) not coated with an odorant molecule attachment material". FIGS. 1, 2A, and 2B of the present application, and the discussion of these figures at page 6, line 11 through page 9, line 21 expressly discloses a measurement element, which is not coated with an odorant molecule attachment material. Moreover, this is simply a negative limitation, which is indicated in the MPEP as not being

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inherently ambiguous or uncertain, and thus acceptable under 35 U.S.C. 112. MPEP 2173.05(i). See also *Ex Parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Claims have been rejected under 35 USC 103(a) as being unpatentable over Fu (US Patent No. 6,598,459). The Final Office Action does not specify to which claims this rejection applies. Applicant will assume that claims 1, 2, 10 – 16, 22, 24, 25, and 27 have been rejected over Fu. This rejection is respectfully traversed. Claims 1 and 22 include the limitation that the measurement element is not coated with an odorant molecule attachment material. Fu teaches that the measurement element must be coated with an odorant molecule attachment material for the device to work. Thus, claims 1 and 22 contain a limitation that is not taught by Fu; therefore, they are not obvious over Fu. To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991). MPEP 2142 and MPEP 2143 – 2143.03. Claims 2, 10 – 13, 15, 16, 24, 25, and 28 depend on either claim 1 or claim 22 and are, therefore, also patentable.

In paragraph 6, the Examiner states an interpretation of the negative limitation "not coated with an odorant molecule attachment material as leaving only a measurement element having a high surface area material and a sensing circuit as elements of the invention." Applicant respectfully does not accept any interpretation of the claims by the Examiner, but instead reads the claim as it is. The claim is simple enough that it does not need any reinterpretation. The Examiner then goes on to state that, based on this interpretation, the claim is not patentable because "it is well settled that removal of an element along with its function is not a patentable step." First, the proper interpretation of the limitation is given at MPEP 2173.05(i) which states that a negative limitation can provide patentable distinction over the prior art. Moreover, this sort of negative limitation to avoid the prior art has been expressly approved of by the courts. See *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). It is noted that the Examiner does not state any MPEP or case law support for his position. If the Examiner maintains this rejection, it is respectfully requested that case law support be provided so that it can be analyzed and addressed. All the case law known to the undersigned relating to the omission of an element or step is not applicable to the present situation since, in this case, there is nothing in the prior art that teaches that the omission of the function might be desirable.

The Examiner also states that the Applicant's argument that Fu would not work if the odorant molecule attachment material were not included "is not persuasive because it would only

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remove its selectivity for a particular molecule, *not all contaminants*. (Emphasis ours.) The Examiner misunderstands the argument, perhaps because we were not clear. Applicant only argued that Fu would not work *for its intended purpose* if the odorant molecule attachment material were not included. The MPEP specifically states that the fact that a prior art reference would not work for its intended purpose with the modification of the claim at issue is a legitimate basis for patentability. MPEP 2143.01 fifth bold heading. Further, the portion of the Examiner's statement in italics is based on Applicant's own disclosure, not Fu, which is improper hindsight. See MPEP 2145X.A and *W.L. Gore & Associates, Inc v Garlock*, 220 U.S.P.Q. 303, 311-13 (Fed. Cir. 1983).

In view of the above arguments, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013183.0174PTUS from which the undersigned is authorized to draw.

Dated: 10/28/05

Customer No. 24283

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